

Appln. No. 10/723,222
Amendment dated April 11, 2008
Reply to Office Action mailed January 14, 2008

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REMARKS

Reconsideration is respectfully requested.

Claims 1 through 3, 6 through 13 and 16 through 31 remain in this application. Claims 4, 5, 14 and 15 have been cancelled. No claims have been withdrawn. No claim have been added.

Parts 1 through 4 of the Office Action

Claims 12, 20 through 23, 25, 27 and 29 have been rejected under 35 U.S.C. §102(e) as being anticipated by Asmussen.

Claim 24 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Asmussen.

Claim 31 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Asmussen in view of Christopher.

Claim 26 has been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Asmussen in view of Brunelle.

Claim 12 requires, in part, "wherein a portion of the real time program is not buffered by the means for buffering to facilitate coincidence of the buffered program with the real-time program".

In the rejection of claim 12, it is alleged that:

wherein the portion of the real time program is not buffered by the means for buffering to facilitate coincidence of the buffered program with the real time program (this is implied in as much as the reference teaches buffered program is played out till it catches with real time program (figs 25-26, col. 45 lines 41-51).

Looking to the portion of the Asmussen patent that is being referenced, it is stated at col. 45, lines 41 through 51 that:

Upon reading the video signal from buffer 1420, various processing of it may occur for subsequent display on a television or

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other display device. For example, the stored video signal is typically converted to an analog signal, amplified, and filtered before transmission to the display device. A transmission point 1425 illustrates a point of transmission of the video program from buffer 1420 to display 1424. Therefore, when the system transmits the video program from the start of the buffer, with transmission point 1425 corresponding to the point of current transmission 1422, the video program is transmitted in real-time.

The fact that the Asmussen patent does not discuss that "a portion of the real time program is not buffered by the means for buffering", as is required by claim 12, is apparently conceded in the rejection, since the rejection states that this requirement of claim 12 is "implied" in the Asmussen patent. It is submitted that the rejection is therefore based upon the position that the Asmussen patent inherently operates such that "a portion of the real time program is not buffered by the means for buffering". It is submitted that reliance upon an "inherent" disclosure of a feature requires that the feature is necessarily present.

The law on establishing that a feature is inherently ("implicitly") present in a document is clear—the Patent Office must "provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art". The burden upon the office is more fully set forth in the MPEP at section 2112, where it states (all emphasis in original, case summaries omitted):

2112 Requirements of Rejection Based on Inherency; Burden of Proof [R-3] - 2100 Patentability

IV. EXAMINER MUST PROVIDE RATION-ALE OR EVIDENCE TENDING TO SHOW INHERENCY

The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference,

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and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

However, it is submitted that the Asmussen system does not necessarily employ this technique (or any other technique as discussed below), nor does it communicate to one of ordinary skill in the art that necessarily a portion of the program is not buffered. The burden is upon the Patent Office to establish that this claimed feature necessarily occurs in the Asmussen system, and that the claimed feature cannot be performed by some other means or technique than that which is claimed.

Moreover, it is also submitted that the Asmussen patent does not disclose that the Asmussen system includes any means for actively causing the "transmission point" to the "point of current transmission". Asmussen merely states that when these two "points" coincide, that the "program is transmitted in real-time". Clearly, the vague reference to "processing of [the video signal]" in the portion of Asmussen relied upon could mean many things, and without any clear statement that the Asmussen system actively attempts to cause a correspondence between the points, one of ordinary skill in the art is left to guess what the "processing" might entail.

Still further, the Asmussen patent suggests that its system avoids the situation where "the user typically would otherwise lose portions of the transmission when the video program is paused" (see col. 45, lines 8 et seq.). It is therefore submitted that one of ordinary skill in the art, considering the discussion in the Asmussen patent, would not be led to the

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requirements of claim 12.

Further, claim 20 requires in part "displaying the buffered program to the user upon the termination of the call until the buffered program coincides with the real-time program" and "wherein displaying the buffered program is performed in a manner faster than reception of the real time program".

It is alleged in the rejection that this requirement of claim 20 is disclosed by the Asmussen patent at col. 46, lines 14 through 17 and col. 50, lines 46 through 52. Col. 46, lines 11 through 23 of Asmussen states that:

Since the video program has been buffered, the user may perform other functions. In particular, the user may rewind the video program, in which case buffer point 1425 moves in rewind direction 1427 to play previous portions of the video program. The user may fast forward the video program, in which case buffer point 1425 moves in fast forward direction 1426 toward the point of current transmission 1422 as the buffered video program is transmitted to display 1424. Accordingly, by transmitting the video program from various points along the buffered portion of the video program in buffer 1420, the user may perform VCR-type functions of real-time or other video programs. Various other buffering methodologies may also be used with the program pause feature.

Further, Asmussen states at col. 50, lines 37 through 52 that:

If the user selected a rewind command (step 1474), the system transmits the video program in rewind direction 1427 from the buffer (step 1484). The system also determines during the rewind if it has reached the end of the buffer at point 1421 (step 1485). Once the system reaches the end of the buffer, it waits for another user command as it cannot further rewind the video program. If the user entered a fast forward command (step 1475), the system determines if the program is transmitted at the current point of transmission 1422 (step 1486). If the program is already transmitted at its current point of transmission, the system cannot fast forward beyond that point and waits for another user command. Otherwise, the system transmits the program in fast forward direction 1426 from the buffer (step 1487), and continues fast forwarding the video program until it reaches the current point of transmission as determined in step 1486.

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However, in each of these portions of the Asmussen patent, the discussion is referring to a "fast forward" function initiated by the user, and not a mode of "displaying [a] buffered program" as required by the language of the claim. It is submitted that these portions of the Asmussen patent do not establish to one of ordinary skill in the art that there is a display of the buffered program "in a manner faster than reception of the real time program", but instead merely discusses moving the current point of transmission through the buffer at an accelerated rate. It is therefore submitted that one of ordinary skill in the art, considering the Asmussen patent, particularly at these points, would not arrive at the requirements of claim 20, and particularly those requirements set forth above.

Claim 21 requires, in part, "a buffer coupled to the controller, wherein the buffer is configured to initiate buffering of the real-time program from the display of caller identification information for the call and provide the buffered program to the display upon the termination of the call until the buffered program coincides with the real-time program".

The rejection of the Office Action cites a number of portions of the Asmussen patent as allegedly disclosing this feature. Generally, these portions of the Asmussen patent are directed to the fast forward function initiated and controlled by the user, as discussed above, and not any ability to "provide the buffered program to the display upon the termination of the call until the buffered program coincides with the real-time program" as required by the claim language.

Claim 22 requires in part "wherein said means for recording records the video input signal prior to detecting an incoming phone call by said means for detecting such that the recorded video input includes a portion of the video input signal prior to detecting an incoming phone call so that displaying the buffered program includes the portion of the video input signal prior to the detecting of the incoming phone call".

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The portions of the Asmussen patent that are referenced in the rejection do not address this. It is noted that among referenced portions of the Asmussen patent, the most pertinent appears at col. 46, lines 6 through 9, where it states:

Upon requesting to play the video program, buffer point 1425 moves toward the beginning of buffer 1422 in order to play a buffered portion that was missed.

Thus, a request to "play the video program" results in "play [of] a buffered portion that was missed", which clearly does not disclose to one of ordinary skill in the art "that displaying the buffered program includes the portion of the video input signal prior to the detecting of the incoming phone call". Thus, even if one believes that the Asmussen patent discloses the storing of a portion of a program before "detecting an incoming phone call", this does not mean that the portion is actually part of "displaying the buffered program includes the portion of the video input signal prior to the detecting of the incoming phone call" as required by the claim.

It is therefore submitted that the Asmussen patent would not lead one of ordinary skill in the art to the applicant's claimed invention as defined in claim 12 and 20 through 22, especially with the requirements set forth above, and therefore it is submitted that claims 12 and 20 through 22 are allowable over the prior art. Further, claims 23, 25, 27 and 29, which depend from claim 12, also include the requirements discussed above and therefore are also submitted to be in condition for allowance.

Withdrawal of the §102(e) and 103(a) rejection of claims 1 through 3, 6 through 13 and 16 through 31 is therefore respectfully requested.

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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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